

REMARKS

This communication is submitted in response to the Office Action of April 9, 2003.

Claims 1-43 are pending in the subject application with claims 1, 23, 29 and 37 having been amended. Claims 2, 3, 7-19, 23-28, 34-36, 40, 41 and 43 stand allowed by the Examiner.

The Examiner's acceptance of the proposed drawing correction submitted with the amendment filed on February 20, 2003 is acknowledged.

The existing Abstract has been replaced with an amended Abstract in which the term "comprises" has been changed to "includes."

Claim 23, which stands allowed, has been amended to correct a typographical error.

The amendments to claims 1, 29 and 37 are clearly supported by the specification as originally filed and do not introduce any new matter.

The rejection of claims 1, 4-6 and 20-22 as being unpatentable over Nesbitt in view of Pierre and the rejection of claims 29-33, 37-39 and 42 as being unpatentable over Nesbitt are respectfully traversed for the following reasons.

Independent claim 1 requires "a shaping member for removable securement on the window structure and defining a cavity over the glass pane; and a layer of solidified compressible material filling said cavity and providing protection for the glass pane, said compressible material being supplied to said cavity in fluidic form and thereafter solidifying in said cavity." Nesbitt discloses heat insulating sheet 14 and heat insulating sheet 15 identical to heat insulating sheet 14. Heat insulating sheet 14 is a plastic sheet comprising a pair of spaced apart layers 16 and 17 with a plurality of plastic hemispheres 18 positioned therebetween to trap air pockets 19 (column 2, lines 33-38; Fig. 3). The

*Ex. agrees but
Nesbitt does not
disclose a
compressible
material
in Figs 6 & 7
which is not
made of spaced apart
layers.*

Examiner acknowledges that Nesbitt does not disclose a shaping member as required by claim 1 and relies on Pierre for the disclosure of a shaping member 34 (Fig. 6). Pierre discloses in Fig. 6 a panel 33 similar to alternative panels 10 and 11 (column 4, line 36). The panel 33 comprises insulating sheet 22 covered by oilcloth 34. The oilcloth 34 corresponds to the board 20 described and shown for panels 10 and 11, and the board 20 is literally disclosed by Pierre as being bonded to the exposed side of the panel (column 3, lines 35-36). There are no teachings or suggestions by Pierre of the oilcloth 34 being disposed along anything other than the exposed side of sheet 22. Accordingly, the oilcloth 34 does not and cannot correspond to the recited shaping member since it does not define a cavity over the glass pane 18. Notably, neither Nesbitt nor Pierre teach or even remotely suggest a compressible material supplied to a cavity of a shaping member in fluidic form and thereafter solidifying in the cavity. Accordingly, the teachings of Nesbitt and Pierre considered in any reasonable combination do not arrive at the claimed invention and claim 1 is submitted to be clearly patentable over Nesbitt and Pierre.

Claims 4-6 and 20-22 depend from claim 1 and are submitted to be patentable for the additional limitations recited therein as well as being allowable with claim 1.

Independent claim 29 recites "a window structure having a glass pane mounted in a frame; and a compressible structure removably secured on said window structure and including a panel of solidified compressible foam material disposed over the exterior of said glass pane with said panel having a thickness extending perpendicular to said glass pane, said thickness being compressible to protect said glass pane from damage due to storms." Nesbitt fails to disclose a panel of solidified compressible foam material. Rather, as pointed out above, Nesbitt requires the insulating sheets to be made of a pair of spaced

apart plastic layers 16 and 17 with a plurality of plastic hemispheres 18 connected to and positioned therebetween. The insulating sheet of Nesbitt is characterized by structural partitioning walls extending between the layers 16 and 17 to define closed compartments providing pockets of air (column 2, lines 38-42). This is in contrast to the compressible foam panel of the claimed invention which does not involve separate structural partitioning members interposed between separate spaced apart layers. The mere fact that Nesbitt discloses air pockets within the insulating sheet does not render the claimed panel obvious except with the use of impermissible hindsight made possible with the teachings of the present invention. In addition to failing to disclose a panel of solidified compressible foam material, Nesbitt fails to disclose the insulating sheet as having a compressible thickness extending perpendicular to the glass pane. The Examiner notes that Nesbitt discloses the insulating sheet may be flexible or pliable and concludes from this feature that the insulating sheet must therefore be compressible in some areas. However, the insulating sheet of Nesbitt is not disclosed as having a compressible thickness. The only reason disclosed by Nesbitt for pliability or flexibility of the insulating sheet is to allow the insulating sheet 54 to be positioned immediately adjacent the frame as well as the glass as disclosed by Nesbitt in Fig. 6, wherein insulating sheet 54 is formed of a plurality of individual insulating sheets 56, 57, 58 and 59. Even though the insulating sheet 54 is pliable to be positioned immediately adjacent the frame 31 as well as the glass 30, the insulating sheet is specifically disclosed by Nesbitt as having a constant thickness (column 4, lines 2-5; Fig. 6). There are no teachings or suggestions whatsoever by Nesbitt of the thickness of the insulating sheet being compressible, and this teaching can only be found in Nesbitt with the use of impermissible hindsight made possible from the teachings of the subject

invention. Where the insulating sheet of Nesbitt is not pliable, it may be indented to allow the sheet to be positioned immediately adjacent the frame as well as the glass as shown in Fig. 7 of Nesbitt for insulating sheet 64 formed by a plurality of individual insulating sheets 65, 66, 67, 68 and 69. Where the insulating sheet is indented as for insulating sheet 64, there is still no disclosure whatsoever by Nesbitt of the thickness thereof being compressible. Accordingly, a panel of solidified compressible foam material of compressible thickness as required by claim 29 is not disclosed by Nesbitt, expressly or impliedly, and claim 29 is submitted to be clearly patentable over Nesbitt.

Claims 30-33 depend from claim 29 and are submitted to be patentable over Nesbitt for the additional limitations recited therein as well as being allowable with claim 29.

Independent claim 37 relates to a method of temporarily protecting a glass pane of a window structure in a building from storm damage and recites the steps of "before a storm arrives, releasably securing a pre-formed panel of solidified compressible foam material over the exterior of the glass pane with the thickness of the panel perpendicular to the glass pane; leaving the panel in place during the storm; compressing the thickness of the panel in response to objects forcefully striking the panel during the storm to protect the glass pane from damage; and after the storm has passed, removing the panel from the glass pane." Nesbitt does not and cannot disclose or suggest the releasably securing step recited in claim 37 since, as pointed out above, Nesbitt does not disclose or suggest a pre-formed panel of solidified compressible foam material. The step of releasably securing required by claim 37 is also not disclosed or suggested by Nesbitt for the reason that Nesbitt does not disclose the step of releasably securing the insulating sheet 54 over the exterior of the glass pane 30, and the step of securing the insulating sheet 54 over the


exterior of the glass pane 30 is not inherent to Nesbitt. Rather, the essence of Nesbitt is to prevent interior heat loss through the window, and interior heat loss through the window would be more efficiently prevented if the insulating sheet 54 is mounted on the interior side of the window. In addition, mounting the insulating sheet on the interior side of the window would be more easily accomplished than an exterior mounting. In addition to not disclosing the step of releasably securing recited in claim 37, Nesbitt does not disclose the recited step of compressing the thickness of the insulating sheet in response to objects forcefully striking the insulating sheet during a storm. As noted above, Nesbitt does not provide any teachings whatsoever of the insulating sheet or any of the other disclosed insulating sheets as having a compressible thickness, and the step of compressing recited in claim 37 is not inherent to Nesbitt. The only purpose for the insulating sheets disclosed by Nesbitt is to prevent heat loss through the window, and achievement of this purpose does not require that the insulating sheets be compressible in thickness to protect the glass pane from damage from objects forcefully striking the insulating sheets during a storm. Accordingly, the method defined by independent claim 37 is not expressly or implicitly disclosed by Nesbitt and can only be considered obvious over Nesbitt with the use of impermissible hindsight. Claim 37 is thusly submitted to be clearly patentable over Nesbitt and should be allowed.

Claims 38, 39 and 42 depend from claim 37 and are submitted to be clearly patentable over Nesbitt for the additional limitations recited therein as well as being allowable with independent claim 37.

A Supplemental Information Disclosure Statement is submitted herewith for consideration by the Examiner.

In light of the foregoing, all of the claims of the subject application are submitted to be in condition for allowance. Action in conformance therewith is courteously solicited. Should any issues in the subject application remain unresolved, the Examiner is encouraged to contact the undersigned attorney.

Respectfully submitted,


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